

REMARKS

STATUS OF APPLICATION

No claims are canceled or added in this paper. Accordingly, claims 3, 4, 6, 8-16, 21-26, 29, and 30 are pending in the present application.

DRAWINGS

The Office Action fails to identify whether the drawings are accepted by the Examiner. Unless an indication is provided by the Office to the contrary, Applicants assume the drawings to be acceptable.

ALLOWABLE SUBJECT MATTER

The indication in the Office Action, that claim 6 is allowable and that claim 26 would be allowable if rewritten in independent form including all of the limitations of the claims from which it depends, is acknowledged with appreciation. Claim 26 has been so amended and is now allowable.

35 USC § 102 REJECTION

Claims 3, 4, 8-16, 21-25, 29, and 30 are allowable over US 6,397,948

The rejection of claims 3, 4, 8-16, 21-25, 29, and 30 under 35 U.S.C. § 102(e), as being anticipated by U.S. Patent 6,497,948 (Williams *et al.*), is respectfully traversed as discussed below.

Claims 3 and 8-16

Claim 3 requires first and second shear members adapted to cooperatively shear a control line as first and second members separate. Claim 12 requires a first control line shear member being attached to a first tubular member and a second control line shear member being attached to a second tubular member (lines 8-9 of claim 12, as presented herein). Further, claim 13 requires a control line passageway comprising a pair of shearing blades adapted to shear a control line during release (lines 5-6 of claim 13, as presented herein). Claims 8-11 depend from claim 3 and claims 14-16 depend from claim 13. Accordingly the remarks provided below concerning claims 3 and 13 apply equally to claims 8-11 and claims 14-16, respectively.

The Office alleges that a shearing blade 39 of Williams *et al.* is the claimed first shear member and that a “slot on top of 22, 24” of Williams *et al.* is the claimed second shear member. Applicants traverse the rejection of claims 3 and 8-16 on two grounds. First, element 22 (*i.e.*, the inner body 22) of Williams *et al.* does not include “a slot on top” as alleged by the Office. Second, the Williams *et al.* apparatus includes only one shearing member.

While the Office alleges such, element 22 (*i.e.*, the inner body 22) of Williams *et al.* does not include a slot on top. Applicants assume that the Office is referring to the shaded portion 31 on top of the inner body 22 (Fig. 3) as the alleged second shearing member. Rather, Williams *et al.* teaches that a “[s]tellite weld overly 31 is provided...about the openings of holes 24 on the top surface of inner body 22” (column 5, lines 11-13, of Williams *et al.*). Further, if the inner body 22 were to define a slot, it would appear in Fig. 4 of Williams *et al.*, but no such slot can be seen. Thus, the stellite weld overlay 31 is not a slot, as believed to be alleged by the Office to be the second shear member. Accordingly, the rejection of claims 3 and 8-16 is deficient and should be withdrawn.

Further, Williams *et al.* discloses only one element which may be construed as a shearing member. “[T]he cutting surface of shearing blade 39 at one end of the upper slot 38 in the outer body 32 sequentially shears umbilical tubes 40 passing through the cross drilled holes in the inner body 22” (column 5, lines 33-36, of Williams *et al.*). If any portion of the inner body 22 were a shearing member, the shearing blade 39 would be proximate to that portion, as viewed in Fig. 4 of Williams *et al.* Rather, Fig. 4 shows that the shearing blade 39 is spaced away from the inner body 22, which serves only to hold the umbilical tubes 40. Williams *et al.* fails to disclose or suggest any shearing member other than the shearing blade 39.

An anticipating reference, by definition, must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990). As Williams *et al.* fails to disclose a second shearing member, it cannot anticipate claims 3 and 8-16. Further, to establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Therefore, Williams *et al.* fails to render claims 3 and 8-16 obvious.

Claims 4 and 21

Claim 4, as amended herein, requires first and second members that are “adapted for releasably connecting devices within a well” (lines 8-9 of claim 4, as presented herein). Claim 21, as amended herein, requires “releasing a first member from a second member, such that devices within a well are released from one another” (lines 2-3 of claim 21, as presented herein).

Williams *et al.* teaches that the break away device 20 is attached via actuation cables 60, 62 to adjacent subsea equipment, such as the multiple quick disconnect (MQC) couplers 50, 52,

respectively (column 5, lines 14-29, of Williams *et al.*). Williams *et al.* is silent with regard to the break away device 20 being adapted to releasably connect devices within a well, as required by claim 4. Thus, claim 4 is allowable over Williams *et al.* and the rejection thereof should be withdrawn.

Claim 29

Claim 29 requires "providing a tubular string comprising a safety sub" (line 2 of claim 29, as presented herein). The Office alleges that the method of Williams *et al.* "teaches providing a tubular string" (page 3, lines 4-5, of the present Office Action) but fails to describe wherein Williams *et al.* the limitation is taught. "[I]t is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). Thus, the rejection of claim 29 is *prima facie* deficient and should be withdrawn.

Further, Applicants assert that Williams *et al.* fails to disclose a safety sub, as required by claim 29. Applicants define the term "safety sub" in the present specification:

Often there is a need to separate a section of tubing from a piece of lower equipment in a well to facilitate the removal of the tubing and completion equipment. For example, the tubing may need to be separated from a sand screen completion and pulled from the well. Such a separation is typically done using a safety sub, but other means of separating are well known to those skilled in the art. A safety sub is designed to provide a known separation point within the tubing string, or its attachments, upon the occurrence of a predetermined event, such as the imposition of a force upon the safety sub. (Page 2, lines 6-12, of the present specification)

As discussed above concerning claims 4 and 21, Williams *et al.* is silent with regard to the break away device 20 being adapted to releasably connect devices within a well. Williams *et al.* fails to disclose or suggest a safety sub, as required by claim 29, and, thus, claim 29 is allowable over Williams *et al.*



Claim 30 depends from claim 29; therefore, the remarks provided above concerning claim 29 apply equally to claim 30.

Accordingly, it is respectfully requested that the rejection of claims 3, 4, 8-16, 21-25, 29, and 30 under 35 U.S.C. § 102(e), as being anticipated by Williams *et al.*, be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited. The Examiner is invited to contact Daren C. Davis at (817) 578-8616 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

WILLIAMS, MORGAN & AMERSON, P.C.
CUSTOMER NO. 23720

January 26, 2004

Kenneth D. Goodman
Reg. No. 30,460
10333 Richmond, Suite 1100
Houston, Texas 77042
(713) 934-4094
(713) 934-7011 (fax)

ATTORNEY FOR APPLICANT

RECEIVED

FEB - 5 2004

GROUP 3600